

REMARKS

In response to the final Office Action dated June 7, 2005 and the Advisory Action dated September 29, 2005, Applicant respectfully requests favorable reconsideration of the above-captioned application in view of the following remarks. The September 7, 2005 Request and its attachments are to be considered incorporated by reference herein. Claims 1-63 remain pending in this application.

Regarding the Argument Presented in the September 29, 2005 Advisory Action

The 9/29/2005 Advisory Action declines to enter the September 7, 2005 Request for the following reason:

[The 9/7/2005 Request] does NOT place the application in condition for allowance because:

There mere fact that the reference patent or application which shows but does not claim certain subject matter and the application which claims it are owned by the same assignee does not avoid the necessity of filing an affidavit or declaration under 37 CFR 1.131, in the absence of showing under 37 CFR 1.132 that the patentee derived the subject matter relied on from applicant note MPEP 715.01(b) and 716.10. The claims stand rejected as outlined in the final office action mailed June 7, 2005. (Note page 2 of the 9/29/2005 Advisory Action.)

However, the Examiner will note that the Applicant has clearly chosen to overcome the rejection under the provisions of 35 U.S.C. § 103(c), not 37 § CFR 1.131 or § 37 CFR 1.132. These are independent bases for overcoming a rejection. Although an affidavit is required by 37 CFR § 1.131 or 37 CFR § 1.132, it is not required by the provisions of 35 U.S.C. § 103(c). Indeed, the very portion of the MPEP cited by the Examiner (MPEP § 715.01(b)) makes this abundantly clear, when quoted in full:

715.01(b) Reference and Application Have Common Assignee

The mere fact that the reference patent or application publication which shows but does not claim certain subject matter and the application which claims it are owned by the same assignee does not avoid the necessity of filing an affidavit or declaration under 37 CFR 1.131, in the absence of a showing under 37 CFR 1.132 that the patentee derived the subject matter relied on from the applicant (MPEP § 716.10). The common assignee does not obtain any rights in this regard by virtue of common ownership which he or she would not have in the absence of common ownership. *In re Frilette*, 412 F.2d 269, 162 USPQ 163 (CCPA 1969); *Pierce v. Watson*, 275 F.2d 890, 124 USPQ 356 (D.C. Cir. 1960); *In re Beck*, 155 F.2d 398, 69 USPQ 520 (CCPA 1946). Where, however, a rejection is applied under 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/ 103, or, in an application filed on or after November 29, 1999, under 35 U.S.C. 102(e)/ 103 using the reference, a showing that the invention was commonly owned, or subject to an obligation of assignment to the same person, at the time the later invention was made would preclude such a rejection or be sufficient to overcome such a rejection. See MPEP § 706.02(I) and § 706.02(I)(1).

Since the statute (35 U.S.C. § 103(c)) and the MPEP (MPEP § 715.01(b)) clearly state that the evidence submitted in the 9/7/2005 Request is sufficient to overcome the Section 103 rejections, the Examiner is respectfully requested to enter the present Request (which incorporates that evidence) and pass the application to issuance without further delay. This is an issue of stark clarity in favor of Applicant.

1 *35 U.S.C. § 103 Rejections*

2 Claim 1-4 and 6-60 were rejected under 35 U.S.C. § 103(a) as being unpatentable
3 over Innes in view of U.S. Published Patent Application No. 2002/0087705 to Smyth.
4 Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Innes in view
5 of U.S. Patent No. 6,006,560 to Gill et al. Claims 61-63 were rejected under 35 U.S.C. §
6 103(a) as being unpatentable over Innes in view of U.S. Published Patent Application No.
7 2004/0015422 to Glick et al. Applicant respectfully traverses these rejections for the
8 reasons stated below.

9 As set forth in the above section of this Request, the subject matter of the Innes
10 published application and the present claimed invention were, at the time the invention
11 was made, subject to an obligation of assignment to the General Electric Company of
12 Schenectady, New York. Accordingly, pursuant to the provisions of 35 U.S.C. § 103(c),
13 the Innes document is not a valid reference against the claimed invention. Since the
14 Innes document is an integral part of the Office Action's three § 103(a) rejections, the
15 Applicant requests that these rejections be withdrawn.

16
17 *Conclusion*

18 The arguments presented above are not exhaustive; Applicant reserves the right to
19 present additional arguments to fortify its position. Further, Applicant reserves the right
20 to challenge the alleged prior art status of one or more documents cited in the Office
21 Action.

1 All objections and rejections raised in the Office Action having been addressed,
2 it is respectfully submitted that the present application is in condition for allowance and
3 such allowance is respectfully solicited. The Examiner is urged to contact the
4 undersigned if any issues remain unresolved by this Request.
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6

7 Respectfully Submitted,

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9 Dated: November 7, 2005

By: 

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